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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/216,012	12/16/98	BROWN S	HHN-015

LM02/0218

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EXAMINER	
CHUNG, C	
ART UNIT	**PAPER NUMBER**
2764	5

DATE MAILED: 02/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/216,012	Brown
Examiner	**Group Art Unit**
Chang Y. Chung	2764

☒ Responsive to communication(s) filed on *Dec 16, 1998*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-10* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-10* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on *Dec 16, 1998* is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *4*

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Claims 1-10 have been examined.

Drawings

2. The drawings are objected to for the reasons set forth in form PTO 948.

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract is objected to because it exceeds 250 words limit. Correction is required.

5. The disclosure is objected to because of the following informalities: Application Serial Number has not been indicated on page 1 and on page 10.

Appropriate correction is required.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 and 5-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,960,403 in view of claim 53 of U.S. Patent No. 5,899,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because both effectively have the same means and method.

As per claim 1, U.S. Patent No. 5,960,403 discloses a method of encouraging patient compliance with a treatment regimen (claim 1), said method including steps for

providing first information about said treatment regimen to a clinician's device (claim 1, particularly items b and c, and claim 4);

sending said first information (claim 1, particularly item e) to a patient's device;

receiving second information from said patient's device regarding compliance with said treatment regimen (claim 1, particularly item a);

sending said second information from said portable proxy device to said clinician's device (claim 1, particularly item b);

analyzing said first information with said second information (claim 1, particularly item c);

U.S. Patent No. 5,960,403 does not explicitly state that the said first information or the said second information is provided or sent to a server. However, official notice is taken that client-server systems are old and well known in the art of computing. Further, the clinic of U.S. Patent No. 5,960,403 contains both a server and a clinician's device as shown on figure 3, and thus effectively acts as a server as mentioned in applicant's invention, as it performs the same functions as disclosed in applicant's system. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use client-server system, with server receiving information, because this would allow efficient exchange of information.

Moreover, U.S. Patent No. 5,960,403 does not explicitly state the comparing of the first information with the second information. However, U.S. Patent No. 5,960,403 does disclose analysis (claim 1, particularly item c), suggesting comparison. Official notice is taken that

analysis that involves comparison is old and well known in the art of analysis and scoring. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use comparison because this would allow analysis of information.

Morever, claims of U.S. Patent No. 5,960,403 does not explicitly disclose a portable proxy device for a client device. However, claim 53 of U.S. Patent No. 5,899,855 discloses client device that is a portable proxy device. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a portable proxy device because this would allow the client device to be more conveniently carried.

As per claim 2, U.S. Patent No. 5,960,403 further discloses a step for altering a sequence of processing steps at said portable proxy device in response to said server device (claim 1, particularly items e and f). It is noted that when a program is executed on patient's device, it alters the sequence of processing steps at the patient's device.

As per claim 3, U.S. Patent No. 5,960,403 further discloses a step for altering a sequence of processing steps at said portable proxy device in response to a result of said steps for comparing (claim 1, particularly items e and f). It is noted that selection of program that is sent is result of the analysis.

As per claim 5, U.S. Patent No. 5,960,403 further discloses steps for presenting a reminder at said portable proxy device regarding following said treatment regimen (claim 1, particularly item e).

As per claim 6, U.S. Patent No. 5,960,403 further discloses steps for presenting a reminder from said server regarding compliance with said treatment regimen (claim 1, particularly item e).

As per claim 7, U.S. Patent No. 5,960,403 further discloses steps for presenting a result of said steps for comparing to an operator ("clinician" as mentioned in U.S. Patent No. 5,960,403) at said server device (claim 20).

As per claim 8, U.S. Patent No. 5,960,403 further discloses steps for receiving a third information at said portable proxy device regarding an effect of an act performed responsive to said treatment regimen (claim 25).

As per claim 9, claims of U.S. Patent No. 5,960,403 does not explicitly discloses the third information that relates to an effect of medicine taken by the patient responsive to the reminder. However, official notice is taken that information that relates to an effect of medicine taken by the patient responsive to medical consultation in medical interactions is old and well known in the art of medicine. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the third information that relates to an effect of medicine taken by the patient responsive to the reminder because this would allow effect of medicine to be communicated.

As per claim 10, U.S. Patent No. 5,960,403 further discloses steps for altering first information in response to third information (claim 1 and claim 25). U.S. Patent No. 5,960,403 discloses continuous feedback loop that alters first information in response to third information.

Applying this feedback loop to method disclosed in claim 1 of U.S. Patent No. 5,960,403 is deemed to be inherent in system of U.S. Patent No. 5,960,403, as it is disclosed on column 17, lines 35-40 of U.S. Patent No. 5,960,403.

8. Claims 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,960,403 in view of claim 53 of U.S. Patent No. 5,899,855, further in view of Chorosinski et al (US 5,945,651).

U.S. Patent No. 5,960,403 does not explicitly disclose steps for controlling a medicine dispenser coupled to the portable proxy device in response to second information. However, figure 13 of U.S. Patent No. 5,960,403 discloses message urging proper medicine dispensing. Further, Chorosinski et al discloses controlling a medicine dispenser coupled to device in response to information (abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have steps for controlling a medicine dispenser coupled to a device in response to information because this would allow proper medication to be dispensed according to feedbacks.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown (US 5,832,448) discloses multiple patient monitoring system for proactive health management. Brown (US 5,899,855) discloses modular microprocessor-based health monitoring system. Kehr et al (US 5,954,641) discloses method, apparatus and operating system

for managing the administration of medication and medical treatment regimens. Kehr et al (US 5,752,235) discloses electronic medication monitoring and dispensing method. Wingrove (US 5,800,458) discloses compliance monitor for monitoring applied electrical stimulation. Kehr (US 5,642,731) discloses method of and apparatus for monitoring the management of disease.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang Y. Chung whose telephone number is (703) 308-6280. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

CYC

Chang Y. Chung

February 10, 2000

James P. Trammell
Supervisory Patent Examiner
Technology Center 2700